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Malcolm Roy

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05/02/2006

IP GROUP OF DLA PIPER RUDNICK GRAY CARY US LLP  
1650 MARKET ST  
SUITE 4900  
PHILADELPHIA, PA 19103

EXAMINER

NELSON, FREDA ANN

ART UNIT

PAPER NUMBER

3639

DATE MAILED: 05/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                 |              |  |
|------------------------------|-----------------|--------------|--|
| <b>Office Action Summary</b> | Application No. | Applicant(s) |  |
|                              | 09/939,986      | ROY ET AL.   |  |
|                              | Examiner        | Art Unit     |  |
|                              | Freda A. Nelson | 3639         |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-66 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-66 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

The amendment received on February 13, 2006 is acknowledged and entered. Claims 38-40 have been amended. No claims have been added. Claims 1-66 are currently pending.

### ***Response to Amendment and Arguments***

Applicant's arguments filed February 13, 2006 have been fully considered but they are not persuasive.

In response to applicant's argument that Nadkarni does not include the fundamental feature of the of all the solicited claims of assigning an Intellectual capital to each of the assigned skills, the examiner respectfully disagrees. Nadkarni discloses that *"The segmentation of the data, that is, the capturing of a candidate's skills or experiences in separate, specific fields (e.g. "Profession", "Category", "Skill", "Specialty"), allows for very precise categorization of skills and experience. As such, the query can be focused and precise and does not rely on the awkward, inefficient, and often error-prone searching of fragments or character strings within long fields (col. 2, lines 53-59); and "In a preferred embodiment, information regarding a candidate's experience or skill profile is structured in layers. For example, the broadest or upper layer may be the candidate's profession. Depending from this layer are a number of categories relating to that profession. Each category may in turn have subcategories within it, all of which relate to the layer above it. This segmentation may be several layers deep. Individual segments (e.g. a subcategory) may also have multi-threaded*

*hierarchical relationships among its members. Furthermore, the relationships between the various layers of segmentation may be I to M, meaning that a subcategory relates to just one category, or M to N, meaning that a subcategory relates to one or more categories (col. 3, lines 21-39).*

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a weighting factor is included in the Intellectual capital code for skill, which allows the Intellectual Capital code to be used to match and rank the individual skills) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The examiner notes that in the last response the applicant stated that a terminal disclaimer was being submitted, however, no terminal disclaimer was attached. Therefore, the examiner is maintaining the nonstatutory double patenting rejection.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 23-44 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to

which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The examiner is unable to determine what the structural make-up of the apparatus is. The applicant is claiming an apparatus, however, the claim language is directed towards a data source which is not a device.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. Claims 23-44 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The applicant is claiming an apparatus without its structural parts needed to realize the functionality of the apparatus.
2. Claims 1-22 are rejected less than 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As per Claims 1-22, these claims recite a series of steps and are considered for the purpose of analysis under 35 U.S.C. 101 as reciting a series of steps. The claims do not recite a pre- or post-computer activity but merely perform a series of steps of establishing a list, receiving a set of skills, identifying codes, adding at least one weighting factor, and storing codes is directed to non-statutory subject matter. A process is statutory if it requires physical acts to be performed outside of the computer independent of and following the steps performed by a programmed computer, where those acts involve the manipulation of tangible physical objects and result in the object

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having a different physical attribute or structure (*Diamond v. Diehr*, 450 U.S. at 187, 209 USPQ at 8). Further, the claims merely manipulate an abstract idea (establishing a list, receiving a set of skills, identifying codes, adding at least one weighting factor, and storing codes) or perform a purely mathematical algorithm without limitation to any practical application. A process which merely manipulates an abstract idea or performs a purely mathematical algorithm is non-statutory despite the fact that it might have some inherent usefulness (*Sakar*, 558 F.2d at 1335, 200 USPQ at 139).

Furthermore, in determining whether the claimed subject matter is statutory under 35 U.S.C. 101, a practical application test should be conducted to determine whether a “useful, concrete and tangible result” is accomplished. See *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1359-60, 50 USPQ2d 1447, 1452-53 (Fed. Cir. 1999); *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1600 (Fed. Cir. 1998).

An invention, which is eligible for patenting under 35 U.S.C. 101, is in the “useful arts” when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result. The fundamental test for patent eligibility is thus to determine whether the claimed invention produces a “use, concrete and tangible result”. The test for practical application as applied by the examiner involves the determination of the following factors”

(a) “Useful” – The Supreme Court in *Diamond v. Diehr* requires that the examiner look at the claimed invention as a whole and compare any asserted utility with

the claimed invention to determine whether the asserted utility is accomplished.

Applying utility case law the examiner will note that:

- i. the utility need not be expressly recited in the claims, rather it may be inferred.
- ii. if the utility is not asserted in the written description, then it must be well established.

(b) "Tangible" – Applying *In re Warmerdam*, 33 F.3d 1354, 31 USPQ2d 1754

(Fed. Cir. 1994), the examiner will determine whether there is simply a mathematical construct claimed, such as a disembodied data structure and method of making it. If so, the claim involves no more than a manipulation of an abstract idea and therefore, is nonstatutory under 35 U.S.C. 101. In *Warmerdam* the abstract idea of a data structure became capable of producing a useful result when it was fixed in a tangible medium, which enabled its functionality to be realized.

(c) "Concrete" – Another consideration is whether the invention produces a "concrete" result. Usually, this question arises when a result cannot be assured. An appropriate rejection under 35 U.S.C. 101 should be accompanied by a lack of enablement rejection, because the invention cannot operate as intended without undue experimentation.

The claims, as currently recited, appear to be directed to nothing more than a series of steps including establishing a list, receiving a set of skills, identifying codes, adding at least one weighting factor, and storing codes without any useful, concrete and tangible result and are therefore deemed to be non-

statutory. While these steps may be concrete and/useful, there does not appear to be any tangible result.

***Claim Rejections - 35 USC § 102***

3. Claims 1-7, 9-21, 23-29, 31-51, and 53-65 are rejected under 35 U.S.C. 102(a) as being anticipated by Nadkarni (Patent Number 6,266,659).

As for claims 1, 3, 12, 23, 25, 34, 45, 47, and 56, Nadkarni discloses the capturing of a candidate's skills or experiences in separate, specific fields (e.g. "Profession", "Category", "Skill", "Specialty"), allows for very precise categorization of skills and experience (col. 2, lines 53-56); Block 205 determines whether or not the employer is satisfied with the results, i.e. whether he has found too many or too few qualified candidates and if not, the process returns to Block 203 where the search query is refined (col. 5, lines 53-56; Fig. 5(d)); and a length-of-time field exists for each skill/category and allows for the summation of time-per-skill across various stretches of employment (col. 2, lines 60-63); the saving means allows the employer to store a number of different candidate qualifications in libraries, which may be combined and modified to form various search queries (col. 9, lines 32-35); and the skills/resume database system is contained in the administration domain 111 and central to the system is a central processing unit (CPU) 101 wherein the CPU 101 may be a single processor, or a combination of processors, which may be configured in a PC, work station, main frame or the like (col. 4, lines 40-45; FIG. 1); and the memory 104 contains a program of instructional means for the system 100 to provide candidates, vendors, and/or employers with "on-line" access to populate and search a resume relational database (col. 5, lines 14-17); and in a preferred embodiment, information regarding a candidate's experience or skill profile is structured in layers. For example, the broadest or upper layer may be the candidate's profession. Depending from this layer are a number of categories relating to that profession. Each category may in turn have subcategories within it, all of which relate to the layer above it. This segmentation may be several layers deep. Individual segments (e.g. a subcategory) may also have multi-threaded hierarchical relationships among its members. Furthermore, the relationships between the various layers of segmentation may be I to M, meaning that a subcategory relates to just one category, or M to N, meaning that a subcategory relates to one or more categories (col. 3, lines 21-39).

As for claims 2, 24, and 46, Nadkarni discloses that that the employer formulates a query based on the requirements of the position opening (col. 5, lines 42-44; FIGS. 2 and 5(a)-5(c)); next, the employer may specify the minimum educational requirements of the position (col. 8, lines 12-14);



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As for claims 4, 26, and 48, Nadkarni discloses that the skills/resume database system is contained in the administration domain 111 and central to the system is a central processing unit (CPU) 101 wherein the CPU 101 may be a single processor, or a combination of processors, which may be configured in a PC, work station, main frame or the like (col. 4, lines 40-45; FIG. 1); and structured as a relational database, it enables a user to input and/or search for data with precision in a central hub for use by those seeking employment and those seeking to hire (col. 4, lines 13-16).

As for claims 5-6, 28, and 49-50, Nadkarni discloses that the system may also have tabular and graphical means of making quantitative comparisons of the selected candidates based on criteria selected by the employer (col. 4, lines 27-30); comparing said selected client position to said prospect' (FIG 6(j)-6(n)); and an employer may therefore specify a profession and a combination of subcategories within that profession for a candidate, whereby using relational database techniques and pattern matching algorithms, the combination can be searched logically within the system's database (col. 9, lines 39-44).

As for claims 7, 29, and 51, Nadkarni discloses that said weighting factor is based upon "Last years Used" (FIG. 5(f)); and a length-of-time field exists for each skill/category and allows for the summation of time-per-skill across various stretches of employment (col. 2, lines 60-63).

As for claims 9, 31, and 53, Nadkarni discloses assigning a monetary value to at least one of said Intellectual Capital codes of at least one of said individuals; storing said monetary value in said data source; and computing a value for said selected individual based upon said monetary value (FIG 6(e)).

As for claims 10-11, 15, 32-33, 37, 54-55, and 59, Nadkarni discloses that the system may provide the means for a candidate to update his information, e.g., his availability status, and/or retrieve information from the database via a telephone or other communicative link; and Block 303 is where the vendor enters details about the candidate's background (col. 2, lines 38-41; FIG 3a).

As for claims 13, 35, and 57, Nadkarni discloses that a personal or other computer equipped with a graphical interface terminal and a telecommunication link (modem, network connection, internet access, etc.), may be utilized to access the system (col. 4, lines 33-36; and operatively connected to the CPU is a database 102 wherein the database 102 can be any computer readable medium such as a hard drive, floppy disk, tape, CD ROM, RAM or other suitable medium (col. 4, lines 46-48).

As for claims 14, 36, and 58, Nadkarni discloses that the formulation of the query search engine (domain 111, FIG. 1) is done by responding to prompts and/or pull-down

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menus from the system that correspond to the standardization, segmentation and organization of the relevant skills (col. 5, lines 44-47; FIG. 4)

As for claims 16, 38, and 60, Nadkarni discloses that from a vendor's perspective, skilled manpower must be dedicated to matching various employers' job requirements with the backgrounds of available candidates and then submitting those candidates' resumes to the respective employers (col. 1, lines 60-65).

As for claims 17, 39, and 61, Nadkarni discloses that in Block 305, the vendor enters details regarding the work one of its candidates is seeking (col. 6, lines 50-51; FIG. 6b); comparing said selected client position to said prospect' (FIG 6(j)-6(n)) .

As for claims 18, 40, and 62, Nadkarni discloses scheduling and tracking said interview process between said prospect and said client (FIG. 6(i)); and indicia can be used to tag the candidate's resume for an employer's search and/or to file the resume immediately in the employer's mailbox, a mailbox corresponding to the position opening, or the like (col. 7, lines 15-18; FIG. 6(m)).

As for claims 19, 41, and 63, Nadkarni discloses that if the employer is particularly interested in a candidate, the employer may schedule an interview on-line with the candidate in Block 207 (col. 6, lines 3-5; FIG. 5(h)).

As for claims 20-21, 42-43, and 64-65, Nadkarni discloses scheduling and tracking said interview process between said prospect and said client (FIG. 6(i)); and indicia can be used to tag the candidate's resume for an employer's search and/or to file the resume immediately in the employer's mailbox, a mailbox corresponding to the position opening, or the like (col. 7, lines 15-18; FIG. 6(m)).

As for claim 27, Nadkarni discloses that to provide access to the system for maintenance, control and monitoring, an administration interface 105 may be operatively connected to the CPU wherein the administration interface 105 is connected to an operator's interface 106, which may include a display and input means, and provides reports 107 (col. 4, lines 62-67); a data source interface communicating between said user interface and said data source, wherein said data source is capable of identifying said Intellectual Capital codes in said data source which correspond to each of said individual's skills storing said selected individual Intellectual Capital codes in said data source for said individual (FIG. 1); and the system may provide the means for a candidate to update his information, e.g., his availability status, and/or retrieve information from the database via a telephone or other communicative link; and Block 303 is where the vendor enters details about the candidates background (col. 2, lines 38-41; FIG 3a).

As for claim 40, Nadkarni discloses scheduling and tracking said interview process between said prospect and said client (FIG. 6(i)); and indicia can be used to tag the candidate's resume for an employer's search and/or to file the resume immediately

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in the employer's mailbox, a mailbox corresponding to the position opening, or the like (col. 7, lines 15-18; FIG. 6(m))

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 8, 30, 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nadkarni (Patent Number 6,266,659).

As for claims 8, 30, and 52, Nadkarni et al. does not explicitly disclose that said weighting factor includes a MUST, PLUS, or ANY identifier and said value in said comparison report is based upon said MUST, PLUS or ANY identifier. However, Nadkarni discloses that the system also uses complex logic to establish the relationships between various members of any subcategory, so that it automatically includes those candidates who have the skills that are functionally superior or inclusive of the ones specified by the employer in the search wherein such relational database search techniques are known in the art (col. 9, lines 39-44). Therefore, it is implied that a the system includes a MUST, PLUS, or ANY identifier to create well defined searches.

5. Claims 22 and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nadkarni in view of Haq et al. (Patent Number 6,275,812).

As for claim 22, Nadkarni not disclose that at least two of said submitted skills are skill bound to each other. Haq et al disclose that there is also a certain skill set (72) associated with each specialty that basically defines that specialty; and to perform each of the roles/responsibilities, a certain combination of skills would be required out of the comprehensive skill list for a specialty (col. 3, lines 28-32); and each specific role/responsibility (71) for a specialty must point (14)(15) to one or more skills (90)(93) in the skill set (72)(col. 3, lines 33-37). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Nadkarni to include the feature of Haq et al. to provide a more defined search.

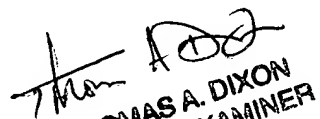
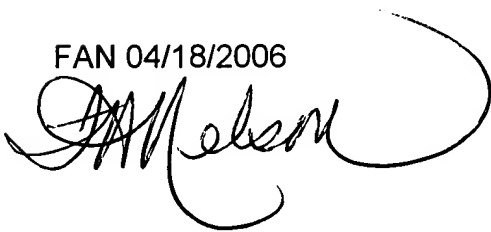
**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Freda A. Nelson whose telephone number is (571) 272-7076. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

FAN 04/18/2006



THOMAS A. DIXON  
PRIMARY EXAMINER